

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Carl de Marcken et al. Art Unit : 3628
Serial No. : 10/714,525 Examiner : Vetter, Daniel
Filed : November 14, 2003 Conf. No. : 2223
Title : GENERATING FLIGHT SCHEDULES USING FARE ROUTINGS AND RULES

Mail Stop Amendment

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed June 30, 2008, applicant **elects** the invention of **Group II** the embodiment of Claims 21-62, drawn to a product, apparatus, and method, classified in class 705, subclass 1. The election is made with traverse.

Applicant traverses this requirement as being untimely and inadequate for reasons discussed below.

The examiner required restriction as follows:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20, drawn to a method, classified in class 705, subclass 5.
- II. Claims 21-62, drawn to a product, apparatus, and method, classified in class 705, subclass 1.
- III. Claims 63-76, drawn to a product and method, classified in class 705, subclass 5.

The inventions are distinct, each from the other because of the following reasons:

2. Invention I is related to inventions II and III as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as iterating over the trip segment and for trip segment retrieving a through fare for that trip segment. See MPEP § 806.05(d).

3. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination III has separate utility such as increasing the diversity of generated itineraries. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together.

Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the

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limitations of the allowable subcombination will be examined for patentability in accordance with 37 C.F.R. 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

The Restriction is Untimely

This application was the subject of an initial Examiner's Action that was responded to by Applicant and a Final Rejection dated September 24, 2007 that was responded to by Applicant on December 21, 2007. In order to secure entry of the Reply to final, Applicant was forced to file a Request for Continued Examination filed on March 21, 2008.

On June 30, 2008, the examiner issued the foregoing Restriction Requirement in response to Applicant's Request for Continued Examination. Applicant contends that this restriction requirement is untimely.

Divisional practice is governed by 35 U.S.C. 121, which permits, but does not require the Director to require restriction in an application, if: "two or more independent **and** distinct inventions are claimed in one application." (Emphasis added). However, under 35 U.S.C. 121, no one can question the validity of a patent for failure of the Director to require the application to be restricted to one invention. Thus, divisional practice is provided for administrative convenience.

The patent office promulgated rules to implement divisional practice under 35 U.S.C. 121. One of those rules is 37 C.F.R. 1.142, reproduced below:

37 CFR 1.142. Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

Under 37 C.F.R. 1.142, restriction can be made at any time **BEFORE FINAL ACTION**.

Since the office submitted a final rejection on September 24, 2007, to which Applicant responded and subsequently filed a Request for Continued Examination this Requirement for Restriction, is procedurally improper and any attempt to maintain the requirement could be considered to be arbitrary and capricious.

As part of the Request for Continued Examination submission, Applicant did by way of preliminary amendment, amend claim 1 to narrow the feature of "determining constraints" by including the features of iterating over the trip segment and for a trip segment retrieving a "through fare" for that trip segment and retrieving a routing corresponding to the through fare.

However, that amendment merely narrows the scope of claim 1 to cover a particular type of fare. Applicant is entitled to narrow his claims, and such narrowing does not give rise to an opportunity for restriction.

In that same preliminary amendment, Applicant did not amend, e.g., claims 21 and 63. These claims were amended in Applicant's reply to the initial office action.

Presumably, after 5 years of pendency, the office has already conducted an exhaustive search of the relevant art. Indeed, all of the claims that are the subject of this restriction were originally filed claims. These claims were the subject of clarifying amendments during prosecution, and at least with respect to the claims in Group II and Group II, the claims remain as there were **before** the final rejection.

In view of Applicant's submission of a Request for Continued Examination, it would be reasonable to conclude that the examiner would not be inconvenienced by examination of the claims presently in the application. The Office in the two prior office actions neither cited new art nor advanced new arguments.

On the other hand, the Office's delay in issuing a restriction requirement in this application prejudices the applicant at least because the Applicant has now lost valuable time in securing patent protection to subject matter that the examiner now seeks to divide out of this application. To require Applicant to submit divisional applications at this late date will delay issuance of at least two of the restricted inventions because of on-going protracted delays in prosecution before the Office.

Applicant notes that at least with respect to the examiner's basis for restriction between Group II and Group III that: "~~subcombination III has separate utility such as increasing the diversity of generated itineraries~~" this feature was present in Group III, as originally filed. So clearly, no amendment of Groups II or III necessitated this requirement.

Applicant had previously paid fees for excess claims in this application and paid fees for continued examination, and thus to the extent that restriction practice is provided to ensure that the Patent Office receives fees commensurate in scope with the work required to properly search an invention, the interests of the office have been already been satisfied and there is no need to require restriction.

The Restriction is Improper

In order for a restriction requirement to be proper, the examiner must show that the inventions are independent (no disclosed relationship there between) **and** distinct (meaning two or more subjects as disclosed are related). Both conditions must be present, in order to properly find a requirement for restriction.¹

The examiner restriction only addresses the "distinct" requirement of 35 U.S.C. 121. The examiner never addressed the independent requirement.

¹ 35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application.

In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

M.P.E.P. §802.01

For two inventions to be independent, the inventions cannot be dependent. M.P.E.P. §802.01 sets forth the meaning of independent:

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

Clearly, "a method executed in a computer based travel-planning-system" a computer program product residing on a computer readable medium for producing itineraries" and "an apparatus" reciting functionally equivalent and related elements are not independent inventions. On this basis alone, the examiner should withdraw the requirement.

In order for the requirement to be proper however, the examiner must also show that the inventions are distinct. M.P.E.P. §802.01 also sets forth the meaning of distinct:

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

The examiner has failed to address how Group I is related to Group II and Group III as subcombinations usable together. The groups are merely expressing claims of varying scope, which Applicant's are entitled to present. The examiner argues that: "**The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as iterating over the trip segment and for**

trip segment retrieving a through fare for that trip segment. See MPEP § 806.05(d)." Applicant contends that this basis is inadequate because it does not lead to an invention in Group I that is separately useable from the invention of Groups II and III, but merely claims of varying scope, which Applicant is entitled to present in a single application.

The examiner also contends, incorrectly, between Groups II and III that: "**In the instant case, subcombination III has separate utility such as increasing the diversity of generated itineraries. See MPEP § 806.05(d).**" This argument is without merit. Again these claims are of varying scope and the feature of increasing the diversity of generated itineraries was present in claim 63, as originally filed and at least this requirement is untimely.

Moreover, explicitly recited in the claims are features that "determine constraints on sequences of flights between the endpoints of the trip segments, the constraints derived from properties of fares that can be used with the flights," as in claim 21. The types of fares used are examples of the embodiments covered by the claims, and not as the examiner urges different inventions.

The examiner has not shown that

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

It is noted that all of the groups are covered by class 705, and Groups I and III are in subclass 5 whereas Group II is in subclass 1. Therefore, item (a) has not been met. The examiner has not shown that the Groups encompass divergent subject matter. Each of the Groups is directed to the same subject matter, namely, pricing of produced itineraries. Therefore, item (b) has not been met. The examiner has not shown that the Groups would require different fields of search or that the prior art applicable to one invention would be

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applicable to the others. Indeed, the office recognizes that a proper search could overlap related fields. Moreover, each of the Groups is directed to pricing of produced itineraries, and would by necessity, use airline travel literature and related patents as the fields of search. Any other fields that would be searched would be commensurate for each of the groups. Therefore, items (c and d) have not been met.

Finally, the examiner has not shown that they would raise different non-prior art issues. Each of the inventions are classified in class 705 and therefore to the extent they raise any non prior art issues they would be presumably similar for all of the groups.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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